



K-C Docket No.: 16,652

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Examiner: Leo B. Tentoni

Serial No.: 09/995,962

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Title: PROCESS FOR MAKING NECKED
NONWOVEN WEBS AND LAMINATES
HAVING CROSS-DIRECTIONAL
UNIFORMITY

PETITION TO ENTER WITHDRAWN CLAIMS UNDER 37 C.F.R §1.144

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This petition is filed in response to the Notice of Allowance mailed 29 March 2004, which included an unauthorized Examiner's Amendment cancelling non-elected dependent Claims 33, 40, 45, 55, 62, 67, 74, 81 and 86. Applicants

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

24 June 2004.

24 June 2004

Date

Manuel J. Peter

Signature

requested rejoinder of these claims in a written request submitted 13 April 2004. The Examiner denied the request in a paper mailed 09 June 2004. Applicants' attorney addressed the Examiner's response in a telephone conversation on 23 June 2004, but did not achieve rejoinder of the claims.

Applicants respectfully petition the Commissioner for rejoinder and entry of withdrawn Claims 33, 40, 45, 55, 62, 67, 74, 81 and 86, pursuant to 37 C.F.R. §1.144. These claims depend from allowed independent Claims 1, 34, 41, 46, 56, 63, 68, 75 and 82, respectively, and are patentable for at least the same reasons as the allowed independent claims. Allowed Claim 1, and withdrawn Claim 33, are illustrative:

1. A process for making a necked nonwoven material having improved cross-directional uniformity, comprising the steps of:

providing a nonwoven web having a central region and two edge regions;

passing the nonwoven web through a first nip having a first average surface velocity, and a second nip having a second average surface velocity higher than the first average surface velocity;

necking the nonwoven web between the first and second nips; and

selectively increasing the necking in the central region of the nonwoven web relative to the two edge regions;

wherein the step of selectively increasing the necking in the central region comprises the step of reducing necking resistance in the central region relative to the two edge regions.

33. The process of Claim 1, further comprising the step of combining the necked nonwoven web with an elastomeric or extendible film.

Each of the independent claims recites a process of making a necked nonwoven material having improved cross-directional uniformity, and lists various process limitations. Each of the withdrawn dependent claims recites an additional process step of “combining the necked nonwoven web with an elastomeric or extendible film”.

The underlying rationale for this petition is that, where an independent claim is found patentable over the prior art, and a dependent claim merely recites an additional limitation, the dependent claim is patentable for at least the same reasons as the independent claim. This can be said without requiring an additional search, without undue effort by the Examiner (other than examining the dependent claim as

to form) and, certainly, without requiring another patent application to have the dependent claim considered.

Dependent Claims 33, 40 and 45 were first presented in a first Amendment filed 16 October 2003. In the same Amendment, independent Claim 1 was broadened to recite a process for making a necked nonwoven material having improved cross-directional uniformity. The term “material” is generic to both a nonwoven web, and a nonwoven web combined with a film. Independent Claims 34 and 41 (directed to a process for making a necked nonwoven material) were added in the same Amendment. The remaining dependent claims presented for review, and the underlying independent claims were added in a second Amendment filed 27 February 2004.

In an Office Action dated 16 December 2003, responsive to a first Amendment, the Examiner rejected independent Claims 1, 34 and 41 (and several dependent claims) as anticipated by or obvious over the prior art. As to dependent Claims 33, 40 and 45, the Examiner stated:

Claims 33, 40 and 45 are withdrawn from further consideration, there being no allowable generic or linking claim...
(emphasis added)

Because Claims 1, 34 and 41 are generic, as explained above, the clear message conveyed by the Examiner was to place these claims in an allowable generic format before dependent Claims 33, 40, and 45 would be considered. Applicants met this burden, and accomplished this objective, via the Amendment filed 27 February 2004. Applicants were surprised by the Examiner's Amendment attached to the Notice of Allowability, cancelling the dependent claims.

M.P.E.P. 809.04 addresses the situation where dependent claims are withdrawn from consideration based on the nonallowability of generic or other linking claims:

Where the requirement for restriction is an application is predicted upon the nonallowability of generic or linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions.

If a linking claim is allowed, the Examiner must thereafter examine species, if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

Form paragraph 8.45 should be used to notify applicant of the allowance of a linking claim and that the nonelected

claim(s) depending from or including all the limitations of the allowed linking claim, previously withdrawn from consideration, is/are rejoined and fully examined for patentability under 37 C.F.R. §1.104... (emphasis added).

Independent Claims 1, 34, 41, 46, 56, 63, 68, 75 and 82 are allowable generic linking claims as defined in M.P.E.P. 809.04. Dependent Claims 33, 40, 45, 55, 62, 67, 74, 81 and 86 depend from and include all the limitations of the respective generic claims. Accordingly, the dependent claims should be re-joined and made part of the issued patent.

Additionally, Claims 33, 40, 45, 55, 62, 67, 74, 81 and 86 were canceled by an improper Examiner's Amendment, made without prior notification or approval by Applicants or Applicants' Attorney. M.P.E.P. 1302.04 states:

The Amendment or cancellation of claims by formal Examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his/her attorney or agent) in a telephone or personal interview. The Examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) interview, and with whom it was held... (emphasis added).

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For this additional reason, Applicants request rejoinder and allowance of these dependent claims.

Applicants believe that no fee is owed for this petition, which is being filed simultaneously with the payment of the issue fee and immediately after receipt of the Examiner latest reply, mailed 09 June 2004. If a fee is owed, then please charge the Deposit Account No. 19-3550.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Maxwell J. Petersen'.

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